

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Final Office Action dated August 3, 2009. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-9 and 11-21 are currently pending in the Application. The amendments to the claims is not intended to narrow the scope of the prior claims and is merely submitted to further prosecution of this matter and to either promote allowance of the claims or at least, reduce pending issues and place the claims into a better condition for appeal. In fact, the amendment to the claims is provided to put the claims substantially in the same form as presented prior to the amendment submitted on April 27, 2009. Accordingly, consideration and entrance of the amendments to the claims is respectfully requested.

In the Final Office Action, claims 1-9 and 11-21 are rejected under 35 U.S.C. §101 because it is alleged that the claims recite limitations that overlap statutory classes. This rejection is respectfully traversed. However, in the interest of expediting consideration and allowance of the pending claims, the Applicants have elected to amend the claims to be substantially in a form as

originally presented. Specifically, the Applicants have elected to make clear that the recited elements are "arranged to" perform the claims recitations as previously presented and in fact, as presented when the application was originally submitted. It is respectfully submitted that each of the recited structural limitations clearly fall within a single statutory class. Accordingly, it is respectfully submitted that claims 1-9 and 11-21 are in proper form and it is respectfully requested that this rejection under 35 U.S.C. §101, be withdrawn.

In the Final Office Action, claims 11 and 12 are rejected under 35 U.S.C. §112, first paragraph. Claim 11 is amended here to correct the claim to make clear that (emphasis added) "upon receipt of the trigger signal, the personal monitoring system is arranged to perform a dedicated wakeup sequence." Support for this claim limitation is found in the specification in the paragraph starting on page 2, line 1. Therein it is stated that (emphasis added) "it is advantageous to arrange the control unit to initiate a switching by the monitoring system into a second mode. Therefore, the control unit must have provisions to generate a code that can be added or superimposed to the first signal. Preferably the code, or the second signal is arranged as a disturbance on the first signal.

This disturbance can be decoded by the processing unit of the monitoring system followed by the monitoring system entering the second mode of operation. It is possible that upon the system entering the second mode a dedicated wakeup sequence is started which may initiate further communication." (See, particularly, the Application, page 2, lines 19-25.) It is respectfully submitted that the amendment to claim 11 to correct this obvious error overcomes the rejection of claims 11-12. Accordingly, withdrawal of the rejections under 35 U.S.C. §112, first paragraph to claims 11 and 12 is respectfully requested.

In the Final Office Action, claims 1-9 and 11-21 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. It is respectfully submitted that the amendment referenced above to place the claims substantially in the same form as presented prior to the amendment submitted on April 27, 2009 obviates this rejection of claims 1-9 and 11-21. Accordingly, withdrawal of the rejections under 35 U.S.C. §112, second paragraph to claims 1-9 and 11-21 is respectfully requested.

In the Final Office Action, claims 1-2, 4-8, 11, 13, 16, 18 and 21 are rejected under 35 U.S.C. §102(b) over U.S. Patent No. 4,987,897 to Funke ("Funke"). Claims 1-9, 11-12, 16-17 and 21 are

rejected under 35 U.S.C. §102(e) over U.S. Patent No. 6,315,719 to Rode ("Rode"). Claims 14-15 and 19-20 are rejected under 35 U.S.C. §103(a) over Funke. These rejections are respectfully traversed. It is respectfully submitted that claims 1-9 and 11-21 are allowable over Funke and Rode for at least the following reasons.

The Final Office Action has interpreted the claims recitations of as being merely functional and has in this way, introduced prior art that does not disclose or suggest the claim recitations. This is very notable in regard to each of the references and particularly Rode, which was dropped as a reference previously since it was clear, that Rode did not disclose or suggest the claim recitations.

The Applicants note the drastic turnaround of understanding in the terms adapted to ... and configured to ... as provided in the Office Action of October 16, 2008 (hereinafter, the prior Office Action). It is not clear why at this late date in prosecution this turnaround was introduced. While the prior Office Action properly notes that these terms (emphasis added) "may be interpreted as intended use", the Office Action thereafter made no attempt to discern whether the recitations in the claims are intended use

recitations or not, and thereafter treated each such recitation as an intended use.

The MPEP in §2111.04 makes clear in reference to such recitations that (emphasis added) "[c]laim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are: (A) "adapted to" or "adapted for" clauses; (B) "wherein" clauses; and (C) "whereby" clauses." The MPEP however points out that "[t]he determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention."

The federal courts in "In re Noll" made clear that a computer that is uniquely configured to perform specified functions through the physical properties of electronic circuits to achieve controlled results is structurally different from a machine without

that program. See, In re Noll 545 F.2d 141, 191 USPQ 721, 726 (C.C.P.A. 1976). The Applicants have identified over fifty-one thousand issued patents that utilize the terms processor or computer together with limitations drawn to being configured to perform operations. The MPEP requires that some analysis as to whether a recitation is a statement of intended use or a structural/operational limitation, however, the Office Action seems devoid of any such analysis.

The claims are amended herein to include the recitations "arranged to" perform the individual claim recitations as discussed above. These recitations clearly are not provided as intended use limitations and in fact, are provided to make clear that each of the claim limitations have particularly structural limitations that are not disclosed or suggested by either of Funke or Rode.

It is respectfully submitted that the system of claim 1 is not anticipated or made obvious by the teachings of Funke and Rode. For example, Funke and Rode do not teach, disclose or suggest, a system that amongst other patentable elements, comprises (illustrative emphasis added) "a sensor arranged to pick up a first signal in a first mode of the system, the first signal being representative of the physiological condition and to forward the

first signal to a signal processing unit, a control unit arranged to be positioned remote from the signal processing unit and to be selectively actuated to effect a system mode change, the control unit being arranged to generate a second signal and transmit the second signal to the sensor superimposed on the first signal, the signal processing unit being arranged to decode the second signal and to make the system enter into a second mode upon receipt of the second signal, wherein the sensor is arranged to receive the second signal as a disturbance of the first signal" as recited in claim 1, and as similarly recited in each of claims 6, and 21.

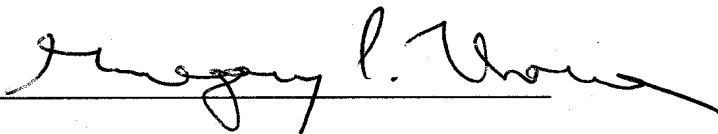
Based on the foregoing, the Applicants respectfully submit that independent claims 1, 6 and 21 are patentable over Funke and Rode and notice to this effect is earnestly solicited. Claims 2-5, 7-9, 11-20 respectively depend from one of claims 1 and 6 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of the claims. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of

argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

By 

Gregory L. Thorne, Reg. 39,398
Attorney for Applicant(s)
October 5, 2009

THORNE & HALAJIAN, LLP
Applied Technology Center
111 West Main Street
Bay Shore, NY 11706
Tel: (631) 665-5139
Fax: (631) 665-5101